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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,981	02/20/2002	Steven P. Bermes	UP-273	6527

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EXAMINER

CHOI, STEPHEN

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/078,981

Applicant(s)

BERMES, STEVEN P.

Examiner

Stephen Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-21 and 27-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-21, 27-36, 39-44 and 49-51 is/are rejected.
- 7) ☒ Claim(s) 37, 38 and 45-48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08).  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 September 2004 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 19, 27-31, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Bianco, Jr. (US 4,463,494).

Bianco discloses all the recited elements of the invention including:

a) a monofilament line (25);

b) a monofilament line cutting tool comprising a tool body (12), a cavity (22), a cutting blade (20) in the cavity, a pair of opposing monofilament line contacting walls located generally parallel with the cutting blade wherein the opposing monofilament line contacting walls are equidistant from the cutting blade (Figure 3). Regarding claim 28, a cutting edge is

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located between the walls (Figure 3). The American Heritage® Dictionary of the English Language (3<sup>rd</sup> ed.) (definition *n.* 1 & 2.) cavity: 1. a hollow; a hole. 2. A hollow area within the body<sup>1</sup>.

4. Claims 35, 42-44, and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Rece (US 1,356,941).

Rece discloses all the recited elements of the invention including;

- c) a pair of opposing contacting walls (at 1, 2);
- d) a pair of opposing retaining walls (at 3, 6);
- e) a cutting blade (11);
- f) a distance between the contacting walls is greater than a distance between the retaining walls (Figure 1).

5. Claim 43 is rejected under 35 U.S.C. 102(b) as being anticipated by Ogletree (US 2,109,303).

Ogletree discloses all the recited elements of the invention including:

- g) a tool body (5);
- h) a cavity in the tool body (Figure 3);
- i) a rectangular cavity opening (Figure 4);
- j) a pair of contacting walls (a,c);
- k) a cutting blade (9) in the cavity.

***Claim Rejections - 35 USC § 103***

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<sup>1</sup> *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 19-21 and 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara et al. (US 4,606,289) in view of McLain (US 4,120,255).

Hara discloses the invention substantially as claimed including a cutting tool comprising a tool body (11), a cavity (13b), a cutting blade (12) in the cavity, a pair of opposing contacting walls located generally parallel with the cutting blade (14, 15). Hara fails to disclose a monofilament line. However, McLain teaches the use of a monofilament line for sewing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a monofilament line as taught by McLain on a sewing machine of Hara as an alternative sewing thread. Regarding claim 20, Hara fails to disclose the tool body made of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the body made of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Regarding claim 21, a pair of opposing retaining walls in the cavity (13a) located generally perpendicular to the cutting blade. Regarding claims 27, 31, and 34, the contacting walls are equidistant from the cutting blade. Regarding claim

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28, a cutting edge is located between the contacting walls (Figure 3). Regarding claims 32-33, a pair of opposing retaining walls are located generally perpendicular to the cutting edge (13a).

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco.

Bianco discloses the invention substantially as claimed except for the tool body made of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the body made of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. It is noted that the common knowledge or well-known in the art statement made in the previous Office action is taken to be admitted prior art because applicant failed to traverse the examiner's assertion.

9. Claims 35-36, 39-41, 44, and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogletree.

Ogletree discloses the invention substantially as claimed except for a distance between the contacting walls is greater than a distance between the retaining walls. However, Ogletree teaches the size or shape may be modified and such modifications would not change the principle of operation. It would have been an obvious matter of design choice to change the distance between the contacting or retaining walls, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

***Allowable Subject Matter***

10. Claims 37-38 and 45-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form **including all of the limitations of the base claim and any intervening claims.**

***Response to Arguments***

11. Applicant's arguments with respect to claims 19-21 and 27-51 have been considered but are moot in view of the new ground(s) of rejection.


***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 571-272-4504. The examiner can normally be reached on Monday-Friday 9:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SC  
2 December 2004

  
STEPHEN CHOI  
PRIMARY EXAMINER